

**THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appeal No:

In re the Application of: **URANO et al.**

Group Art Unit: **1626**

Serial Nos.: **90/004,812 & 09/810,650**

Examiner: **STOCKTON, Laura**

Filed: **October 23, 1997**

P.T.O. Confirmation Nos.: **8528 & 8670**

For: **DIAZODISULFONES**

MERGED REISSUE & REEXAMINATION PROCEEDING
REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 26, 2006

Sir:

This Reply Brief is being submitted **along with a Request for Oral Hearing** to rebut the

Examiner's Answer dated July 26, 2006.

I. ARGUMENT

A. THE BOARD IS OBLIGATED TO REVIEW AND RECTIFY THE DENIAL OF THE APPELLANT'S DUE PROCESS RIGHT TO AN UNBIASED EXAMINATION CAUSED BY THE EXAMINER'S VIOLATION OF THE FEDERAL CIRCUIT RULES WHICH HAVE SEVERLY PREJUDICED THE APPELLANT

The Examiner's citation of a nonprecedential opinion, in violation of Federal Circuit Rule § 47.6(b), has denied the appellant its due process right to an unbiased examination and a reexamined patent on its application. The Examiner committed serious legal error under Federal Circuit Rule § 47.6(b) by employing and liberally citing against the appellant a nonprecedential opinion as precedent. *Burke Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 51 USPQ2d 1295 (Fed. Cir. 1999), holds that a nonprecedential opinion may only be used if it invokes the exact same claims of the same patent. The Examiner cannot deny the appellant's Constitutional due process right to an unbiased examination and right to a patent and immunize clear prejudicial legal error by stating only that it "is a new issue raised by the appellant in the Brief" (Examiner's Answer p.8, text lines 18-19).

The Board of Appeals and Interferences is obligated to address this Constitutional violation of due process irregardless of whether the issue was raised for the first time on appeal because Constitutional due process rights are ongoing, the Board is the proper body to address the violation and the Board should address the issue *sua sponte* even if it was not raised by appellant. Through the Administrative Procedure Act 5 USC §706(2)(A) and (D), a Patent Office Examiner is required to act in accordance with the law. The

APA § 706(2)(A) and (D) give a reviewing court the authority to hold unlawful and set aside agency findings and conclusions found to be arbitrary, capricious, and an abuse of discretion or otherwise not in accordance with the law or that are made *without observance of the procedure required by law*. Therefore the **Patent Office is not immune from review where it has violated the appellant's due process right** to a patent through an Examiner to prejudice an applicant.

The appellant prays that the rejections of the final Office Action relying on the rationale of *In re Wako* should be expunged from the record, or the final Office Action should be reissued, because the rejections are contrary to law, confusing and highly prejudicial to the appellant. Based on the existence of written description support of claims directed to two specific chemical compounds shown *infra*, claim 8-11 should be allowed.

B. THE EXAMINER'S FINDING OF LACK OF SUPPORT IN THE PRIORITY DOCUMENT UNDER 35 USC §112 IS LOGICALLY AND LEGALLY ERRONEOUS

The appellant continues to argue support for the claimed compounds 8-11 in the priority document because, as will be shown in the rebuttal below, the Examiner's reasoning for denying support is logically and legally erroneous.

First, the Examiner admits the following support in the Examiner's Answer from p.11, text line 13 to p.12, text line 5:

The Examiner did admit that the language in claims 8 and 9 was found in the priority document, the language being "cyclic alkyl group" (page 14, line 7 of Appellant's English translation of their Japanese priority document submitted in

the Reexam on August 3, 1998), “branched” (page 14, line 7), “hexyl” (page 14, line 10) and “butyl” (page 14, line 10). **This language, “cyclic alkyl group”, “branched”, “hexyl” and “butyl”, is found under the definition of “alkyl” in the Japanese priority document.** However, the question that arises is does the **definition of “alkyl”, along with the definitions of other possible substituents** that R^1_o and R^2_o could represent, give adequate written description or support for any sub-genera (as found in instant claims 9 and 11) or species (as found in instant claims 8 and 10) without any further guidance or direction from the Japanese priority document. (emphasis added)

The Examiner admits further support in the priority document on p.16, lines 2-10 as follows:

In Appellant’s Japanese priority document {JP2-019614} filed January 30, 1990, the R^1_o and R^2_o {or R^1 and R^2 } **variables are defined, each independently from the other, as “a straightly linear, branched or cyclic alkyl group having 1 to 10 carbon atoms”.** **There are also a number of other substituents that are represented by the R^1_o and R^2_o variables.** None of the specific compounds disclosed and claimed in the instant application were disclosed in Appellant’s Japanese priority document. (emphasis added)

From the Examiner’s own explanation above about the priority document one knows that R^1_o and R^2_o are defined and that there are other substituents represented by R^1_o and R^2_o . In the Examiner’s Answer, the Examiner awkwardly disconnects admission of the other substituents from each other, as explained on p.11 of the Answer as a “cyclic alkyl group”, “branched”, “hexyl” and “butyl,” rather than reading the relevant portion of the priority document as a whole as the skilled chemist would do.

The Examiner has admitted that the appellant has defined the substituents represented by R^1_o and R^2_o . **The act of defining R^1_o and R^2_o is what 35 USC § 112 contemplates, in order to show that the appellant had possession of the claimed compounds.**

Again, the specific disclosure in the priority document is a common shorthand listing of compounds based on the diazodisulfone structural formula on p.14, lines 6-10 as follows:

...as the straight-chain, **branched** or **cyclic** alkyl group or the alkyl group in the haloalkyl group represented by R^1_o and R^2_o , **there are included** C_{1-10} alkyl groups such as methyl, ethyl, propyl, **butyl**, amyl, **hexyl**, octyl, and decyl group.
(emphasis added).

The plain English description states what R groups “are included.” As for present claim 8, the only possible issue is whether the skilled chemist would recognize that cyclic hexyl exists as an R group. The plain description above states that cyclic alkyl isomers are part of the invention and specifically that the R groups include hexyl groups. A skilled chemist of 1990 or 1890 knows that all isomers can exist and that since hexyl is specifically recited it is also the invention. Since the claimed R group is identified specifically in the list above, it exists.

Before the Examiner admitted what was in the priority document, she explained the level of the skilled artisan, in order to maintain her 35 USC § 103 rejection of the claims on p.7, lines 1-14:

Finding of prima facie obviousness –rational and motivation (MPEP §2142-2413)

The indiscriminate selection of “some” among “many” is *prime facie* obvious. The motivation to make the claimed compounds derives from the

expectation that structurally similar compounds would possess similar activity (e.g., forms a strong acid on exposure to actinic radiation).

One skilled in the art would thus be **motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation.**

The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art. (emphasis added)

This entire appeal is based on the fact that it is logically erroneous, that with “the indiscriminate selection of “some” among “many”” being “*prime facie* obvious” and “[t]he motivation to make the claimed compounds” deriving “from the expectation that structurally similar compounds would possess similar activity”, that the skilled artisan, only nine months earlier, would not be able to immediately determine from the disclosure:

...as the straight-chain, **branched** or **cyclic** alkyl group or the alkyl group in the haloalkyl group represented by **R¹_o** and **R²_o**, **there are included** C₁₋₁₀ alkyl groups such as methyl, ethyl, propyl, **butyl**, amyl, **hexyl**, octyl, and decyl group. (emphasis added)

that the claimed:

R¹ is a **cyclic alkyl group** in which the alkyl group is **hexyl**; and R² is a **cyclic alkyl group** in which the alkyl group is **hexyl**;

and that

R¹ is a **branched alkyl group** in which the alkyl group is **butyl**; and R² is a **branched alkyl group** in which the alkyl group is **butyl**;

are not supported. The Examiner's conclusion is factually and legally erroneous based on the standard of 35 USC § 112.

The Examiner has committed obvious error which must be reversed. It is impossible that the skilled artisan so "motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation," would not be able to see support for the same compounds given the same definition of a diazodisulfone and the alkyl groups, as found in the priority document.

It is the appellant's position that, as the Examiner admits in the Examiner's Answer on p.16, lines 13-14 that, "the **very small sub-genus** found in instant claims 9 and 11" and "the **species** disclosed and claimed in instant claims 8 and 10" (emphasis added) are fully disclosed in the appellant's priority document as would understood by the art skilled person, **having the level of skill admitted by the Examiner.**

Not wanting to confuse the standard for support under 35 USC § 112 with the standard for obviousness under 35 USC § 103, the appellant asserts that the skilled artisan, with the "expectation that structurally similar compounds would possess similar activity", would immediately see that the claimed compounds are disclosed in the priority document. The Examiner asserts that none of the specific compounds are disclosed in the priority document only because in the Examiner's incorrect opinion, the disclosure must be a mirror word-for-word disclosure. The priority document, in fact, defines the claimed compounds in ordinary chemical diction. While skilled artisans may describe compounds one way and claim drafters another, the

description is the same species or very small sub-genus. **How the skilled artisan could possibly have a chemical understanding like an “expectation that structurally similar compounds would possess similar activity” and completely lack an understanding of definition of R^1 and R^2 , in terms like “ R^1 and R^2 , there are included C_{1-10} alkyl groups such as methyl, ethyl, propyl, butyl, amyl, hexyl” is logically and legally erroneous.** The appellant’s own definition describes the species and very small sub-genus of compounds for which the skilled artisan has, as the Examiner admits, “the expectation that structurally similar compounds would possess similar activity.” **It is simply impossible for the skilled artisan to have expectations about the structural similarities of the compounds, without on the other hand being able to find support for the compounds which the artisan has expectations about only nine month later after looking at Pawlowski et al.**

The appellant’s priority document describes diazodisulfones - the chemical properties, the structure and has defined individual structural species. The appellant requests that the obvious chemical support for claims 8-11 finally be recognized and the Examiner’s clear error be reversed.

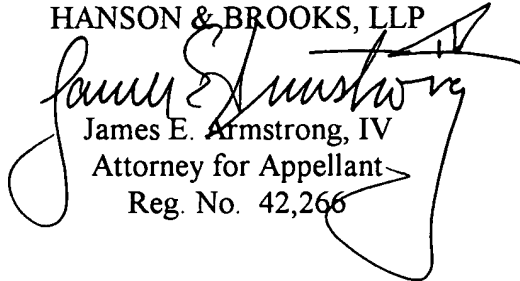
II. CONCLUSION

The final rejections should be withdrawn to remove rejections prohibited by law and the claims should stand allowed and passed to issue.

In the event this paper is not timely filed, appellant hereby petitions for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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